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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,191	06/25/2004	Masahiro Sano	Q82273	9237

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,191

Applicant(s)

SANO, MASAHIRO

Examiner

Geoffrey L. Knable

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-25-04</u> . | 6) <input type="checkbox"/> Other: ____. |

1. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

From an examination of the figures and especially what is marked as cross-section A-A in fig 4, as well as cross-section B-B in the prior art fig. 1, it is not clear how the figures that are said to correspond with these cross-sections (e.g. figs. 3 and 2) correlate with these figures and if they do correspond to the cross-sections indicated in figs. 1 and 4 (i.e. if the lines A-A and B-B are not in error), then how the sidewall is configured is entirely confusing, it being submitted that in such case, the ordinary artisan would not be able to practice the invention without an undue burden of experimentation. It has been assumed that the indicated marked sections A-A and B-B in figs. 4 and 1 are in error (note as just an example, the cross-section lines as drawn are essentially *parallel* to what are assumed to be the generally radially oriented serrations 15 or 101 - in such case, however, they would not cross any of the serrations, this seeming to contradict all of the actual figures that are said to depict cross-sections). Clarification is required.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 3, the scope of what defines a "decorative portion" is entirely indefinite and confusing - in particular, the defining language of this portion "having tops and bottoms continuous with each other thereon is arranged" is not understood. What

are the "tops" or "bottoms" and how are they defined (e.g. top and bottom relative to what direction?)? Note for example that this could be read as inclusive of top and bottoms relative to the radial direction in which case this would require almost no more than simply that the tire has a sidewall portion that can be in some way decorative (i.e. the top could be defined as the radially outer part of the sidewall while the "bottom" could be defined for example as the radially inner portion thereof). It would not seem that this is what is intended but clarification is required. Is this language for example intended to define or require the essentially serrated background pattern illustrated? If so, clarification of the language is required. As the scope of what constitutes this pattern is critical to the invention, it is important that the scope of this be definite.

Likewise, it is not entirely clear how the claimed "joined portions" are defined, especially as it is not clear what defines the decorative portion. Thus for example, although it is clear that this is not intended, note that it seems the "joined portions" could be said to read on the portion "101" between the two protruding portions in (prior art) fig. 2 since this part joins the two adjacent protruding portions, the tops of this portion being higher than the bottom of the decorative portion. In other words, the scope of what does and does not define or comprise a "joined portion" is not sufficiently clear and definite so as to avoid such an interpretation.

Note also that the reference to "the tops continue with each other thereon" in claim 2 is likewise indefinite for essentially the same reasons noted with respect to claims 1 and 3.

In claim 5, reference is made to a "corner region connecting the decorative portion and each protruding portion" - it however is not clear how this corner region relates to the previously defined "joined portions", these apparently overlapping definitions creating potential for confusion.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 7/1 and 7/2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 6-6967-Y2 (cited by applicant).

JP '967 discloses a tire including a sidewall having a serrated background pattern (e.g. cross-section A-A in fig. 2 and apparently fig. 4) defining what is considered to be a decorative portion having tops and bottoms continue with each other as claimed.

Further, protruding portions higher than the tops of the decorative portions are provided in the pattern defining the letters - note esp. 2a in fig. 5, this figure corresponding to cross-section C-C in fig. 2. Further, the base of adjacent protruding parts (e.g. where 4a and 4b meet in fig. 3) is higher than the bottoms of the decorative portion (e.g. note esp.

fig. 5). This reference is therefore considered to anticipate what is defined in claim 1, the ambiguities already noted however preventing a complete and accurate comparison, any differences however being considered obvious optimizations of this basic teaching. As to claim 2, the multiple parts 4 as illustrated in fig. 3 are considered to form a "high decorative part" consistent with this claim. As to claim 7, the illustrated relative dimensions as well as described dimensions for D1 and D2 are considered to suggest or certainly render obvious relative heights within the broadly claimed range.

6. Claims 3, 4, 7/3 and 7/4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-6967-Y2 (cited by applicant) as applied to claims 1, 2 and 7 above, and further in view of at least one of Clementz et al. (US 5,303,758) and Ratliff, Jr. (US 2002/0174928).

Given that the artisan apparently understands that ridged sidewall patterns can desirably either have ridges directly connected (e.g. figs. 8A-8D of Clementz et al.; figs. 4D-5D of Ratliff, Jr.) or spaced by a flat distance (e.g. figs. 6, 7 and 8E of Clementz et al.; figs. 4A-4C of Ratliff, Jr.), it is considered to have been obvious to provide the ridged pattern "4" of JP '97 with a flat space between adjacent ridges, this being considered to then provide flat portions between protruding portions that are higher than the decorative pattern as required by claims 3 and 4.

7. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over D204585 to Vizina.

Vizina discloses a tire including a sidewall having a serrated background pattern (e.g. note various cross-sections) defining what is considered to be a decorative portion

having tops and bottoms continue with each other as claimed. Further, protruding portions higher than the tops of the decorative portions are provided in the pattern (esp. fig. 5) with a base between adjacent protruding parts (i.e. the flat part between each of the two raised portions in fig. 5) being higher than the bottoms of the decorative portion (e.g. note again esp. fig. 5). This reference is therefore considered to anticipate what is defined in claim 1, the ambiguities already noted however preventing a complete and accurate comparison, any differences however being considered obvious optimizations of this basic teaching. As to claim 2, these flat parts between the raised parts can be said to define a "high decorative portion", it not being seen how the claim defines over this. As to claim 3, note that the parts between adjacent protruding parts are flat and can be said to suggest or render obvious the claim 4 relative dimensions reading the dimension of the protruding ends as being from for example the outer ends thereof. As to claim 7, the illustrated relative dimensions are considered to suggest or certainly render obvious relative heights within the broadly claimed range, it being stressed that the illustrated design being a design patent would have been read to be a more accurate representation of how the final structure should be relatively configured.

8. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over [JP 6-6967-Y2 (cited by applicant) alone or further in view of at least one of Clementz et al. (US 5,303,758) and Ratliff, Jr. (US 2002/0174928)] or D204585 to Vizina as applied above, and further in view of JP 2000-255224 (cited by applicant) and optionally Ratliff, Jr. (US 5,807,446).

To radius corner regions as claimed would have been obvious in view of JP '224 - note esp. fig. 3 and the abstract which indicates that R can be 0.2mm, it being considered that the artisan would have understood that a radiused connection would tend to help avoid cracking - note also the teachings of Ratliff, Jr. '446 in this regard (col. 3, lines 18-19).

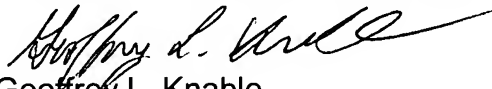
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2003/0084979 to Matsumoto (esp. fig. 5), Oyama (US 6,832,638 - esp. fig. 2b), Baker (US 6,053,228 - esp. fig. 5) and Attinello et al. (US 5,645,660 - esp. fig. 8) can also be said to define patterns that include relatively raised joining parts and thus arguably are consistent with at least some of the claims but they are less relevant than the applied art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
March 14, 2006